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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,023	06/01/2000	Riccardo Dalla-Favera	50995-B/JPW/EMW	4436

7590 04/02/2004

Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER
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MCGARRY, SEAN

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 04/02/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/585,023

Applicant(s)

DALLA-FAVERA, RICCARDO

Examiner

Sean R McGarry

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/19/03 has been entered.

Claim 89 was rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility. This rejection has been withdrawn in view of the evidence of utility provided in the submitted "Exhibit A" Iida et al. [Nature Genetics Vol. 17:226, 1997].

Claim 89 was also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. This rejection has been withdrawn in view of the evidence of utility provided in the submitted "Exhibit A" Iida et al. [Nature Genetics Vol. 17:226, 1997].

Claim 89 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment filed 9/19/01 and entered upon the RCE filed 2/19/02 introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendments to claim 89 include the limitation "or a fragment thereof" referring to a MUM-1 protein SEQ ID NO: 14. Applicant has pointed to page 12, lines 17-32, page 14, lines 26-30, Figure 7 and Figures 12A and 12B. Support for a protein fragment of MUM-1 could not be found at these cites. A review of the specification did not find support for such a limitation. The support referred to provides a description of nucleic acids and does not provide support, specifically or even indirectly for MUM-1 fragments.

Applicant is required to cancel the new matter in the reply to this Office Action.

Applicant's arguments filed 5/19/03 have been fully considered but they are not persuasive. Applicant argues that the term fragment thereof in context with the claimed protein is supported by the disclosure. Applicant points to page 12, line 25 which refers to restriction fragments within the MUM-1 coding region which is shown in Figure 7. The restriction fragments referred to are fragments of a nucleic acid molecule. There is simply no discussion or connection to any protein fragments in the context of the

disclosure at page 12 and Figure 7. Applicant also argues that Figure 7 shows a restriction map of MUM-1 and provide Exhibit B as evidence of protein fragments. Exhibit B and Figure 7 are drawn to a restriction map of a nucleic acid molecule and hence nucleic acid fragments. Nowhere in the application as filed is there any disclosure or even teaching that these nucleic acid fragments might correspond to some protein fragment species in the context of the claimed invention. The specification simply does not disclose any protein fragments. The context of the disclosure of the restriction map of Figure 7 is clearly that of a nucleic acid characterization where there is no disclosure, discussion, or even hint of protein fragments.

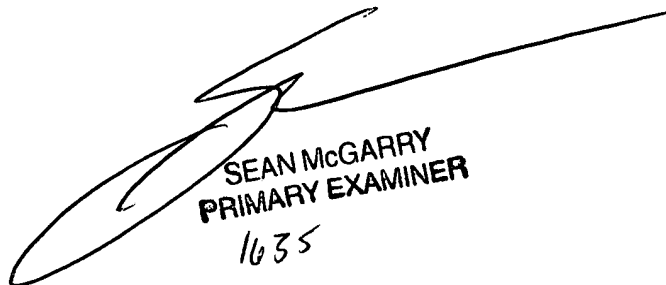
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean R McGarry whose telephone number is (571) 272-0761. The examiner can normally be reached on M-Th (6:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (571) 272-0760. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SRM



SEAN MCGARRY  
PRIMARY EXAMINER  
1635